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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,383	08/28/2001	Dana C. Bookbinder	SP01-243 / 9272-7	6010
20792	7590	06/14/2004	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC			HOFFMANN, JOHN M	
PO BOX 37428			ART UNIT	
RALEIGH, NC 27627			PAPER NUMBER	

1731

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/941,383

Applicant(s)

BOOKBINDER ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12,38-43,47 and 48 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-12,38-43,47 and 48 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no mention of any "exit opening" in the specification. (see claim 1 for instance) Claims are to be interpreted in light of the specification. One cannot interpret that which is not describe in the specification.

There is also no mention of the top plate "extending across" the second end. Claims are to be interpreted in light of the specification. One cannot interpret that which is not describe in the specification. (see claim 41)

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support for the claim 41 for the limitation of the top plate extending across the second end. Examiner did a text search of the specification, but could find

no mention that the top plate extends across the second end. Examiner could find no implicit support for this. (See below.) This establishes a prima facie showing of failure to comply with the requirement. The burden is now on applicant to demonstrate that the claim does comply.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

To examiner, the top plate as shown and described does not "extend across" the second end as indicated in claim 41. There is no description, definition or even mention of such. One of ordinary skill would be uncertain what is meant by this claim. As indicated in the prior art rejection below, it appears that the prior art top plate extends across the second end - but Examiner cannot figure out whether it does or not because there is no hint as to what is meant by such. To Examiner, if something extends across a circle, it would have to also extend over the center of the circle as well. However it is clear from Applicant's disclosure that such is not the intended limitation, because there is a big hole there. Therefore, Applicant must mean something else by "extending across". The lack of description places an unreasonable burden upon the public – for those who want to know what the claim covers. See also the prior art rejection of claim 41 below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-7, 9-12, 38-43 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2000-44269. Claims 1-3, 5-7, 9-12, 38-43 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Koaizawa 6543257.

It is noted that both of these references are related to an EPO abstract submitted by Applicant. Since there is no translation is available, the US Patent 6543257 is relied upon to show what the Japanese reference discloses.

Looking to figure 11 of the Koaizawa: 2 is the muffle tube. 2b points to the top plate. 7 is the heating device. 9 is a gas feed port which is disclosure of a process gas supply. 4 is the handle; 5 is the coupling portion. 28 is the flow shield. 41 is the washer.

Claims 2, 5, 11-12, 38, 42 are clearly met.

Claim 3: col. 24, lines 60-62 indicates that the means-cum-insulating means (of which 28 is one) is between 5-20 mm.

Claim 6 it is deemed that the shield is substantially coupled to the coupling device 5, because the only way to remove the shield is by moving it straight up.

Claim 9: see col 22, lines 18-19.

Claim 10: see col 15, lines 66-67.

Claims 39-40: see figure 20.

Claim 43: again looking at figure 11: 2 is the tubular muffle. 41 is the top plate with a passage. 3 is the solid flow restrictor positioned over the passage 44. As to the passage having a hole with a second dimension: the Koaizawa passage is a hole each has at least two dimensions which may or may not have the same value: the length is one, the width/diameter is another.

Claim 47 is substantially the same as the other claims. However, claim 47 also requires a plurality of washers. It is deemed that the major horizontal flat surface of 23b, and the major upper flat surface (at the same level as the middle coil 22) are two other washers. Although these washers have vertical walls attached to them, the claims in no way preclude such. --The mere fact that a given structure is integral does not preclude its consisting of various elements- - *Nerwin v. Erlichman*, 168 USPQ 177, 179 (PTO Bd. Of Int. 1969).

Claim 7: see figure 10. The washer is deemed to be the 12 with a dome attached to the washer. All the other limitations are clearly met in that figure 10 is substantially the same as figure 11 in the other respects.

As to claim 41: Note above that Examiner could not ascertain what is meant by "extending across". It is deemed that that any thing that lies on both sides of the hole is

Art Unit: 1731

"extending across" the hole. The top plate 2b extends across the second end in as much as Applicant's invention does.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000-44269 or Koaizawa 6543257.

There is no indication as to what the prior art shield's thickness is. It would have been obvious to have the shield as thick as necessary to prevent gas flow, and yet strong enough to withstand the hot environment.

Claim 8 – see how claim 7 is met above. There is no indication of the spacing. It would have been obvious to make the furnace/preform as large or as small as desired – depending upon how much fiber is desired.

***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

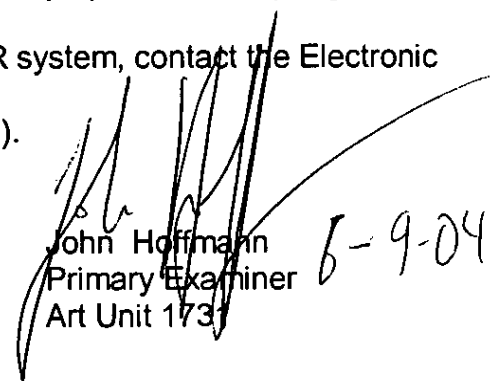
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 1731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John Hoffmann  
Primary Examiner  
Art Unit 1731

6-9-04

jmh